



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/008,957 01/20/98 MORIARTY

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EXAMINER

HM12/0104

BULLWINKEL PARTNERS
SUITE 1300
19 SOUTH LASALLE STREET
CHICAGO IL 60603-1493

RADIO, B

ART UNIT

PAPER NUMBER

1616
DATE MAILED:

01/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
09/008,957

Applicant(s)
Moriarty et al.

Examiner
Barbara Badio

Group Art Unit
1616



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Dec 13, 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☐ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
 - ☐ will not be entered because:
 - ☐ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

- ☐ Applicant's response has overcome the following rejection(s): _____

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
Claims allowed: _____
Claims objected to: _____
Claims rejected: 1-6 and 10-19
- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

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DETAILED ACTION

1. Applicant's declaration was considered but not persuasive for the following reasons.

The prior art teaches that the compounds are less hypercalcemic and/or hypercalciuric (see Bishop et al., '429, col. 5, line 60 - col. 6, line 13). The declaration does not show a statistically significant difference between the prior art compound and the claimed compound. Based on the prior art, the ordinary artisan would expect the compound to be less hypercalcemic and/or hypercalciuric. He would also expect differences in the potency of the compounds as shown by the declaration.

It is also noted that the prior art teaches $1\alpha(\text{OH})\text{D}_4$ and $1\alpha,25(\text{OH})_2\text{D}_4$ which are closer to compounds of claims 2 and 3 than $1\alpha(\text{OH})\text{D}_3$ and $1\alpha,25(\text{OH})_2\text{D}_3$ shown in the declaration.

For these reasons and those given in previous Office Actions, the rejection(s) as indicated in Paper No. 11 are maintained.

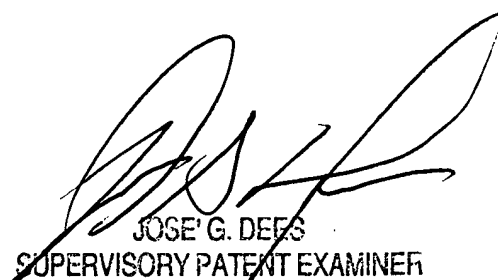
Telephone Inquiry Contacts

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616

BB
December 23, 1999